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REMARKS

This is a full and timely response to the non-final Official Action mailed March 6, 2008 (the "Office Action" or "Action"). A request for a one month extension of time and the requisite fee accompany this amendment. Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

Claims 23-51 were cancelled previously without prejudice or disclaimer in response to a Restriction Requirement.

By the forgoing amendment, various claims have been amended. No claims have been added or cancelled. Thus, claims 1-22 are currently pending for further action.

Claim Objection:

The outstanding Office Action objected to claim 5 due to a minor typographical error. Accordingly, claim 5 has been amended herein to correct this error. Following entry of this amendment, the objection to claim 5 may be reconsidered and withdrawn.

Prior Art:Rejections under § 102:

Claims 1-3, 8, 9, 11, 12-14, 19-20 and 22 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent App. Pub. No. 2003/0192054 to Birks et al. ("Birks"). For at least the following reasons, this rejection should be reconsidered and withdrawn.

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Claim 1:

Claim 1 recites:

A method for expanding the functionality of a content receiver comprising a set-top box, said method comprising:
receiving a command from a downstream content receiver *requesting Internet access*; and
executing the command if the command is not directed to a server further upstream, *wherein executing the command provides access to the Internet to said downstream content receiver.*

(Emphasis added).

Support for the amendment to claim 1 can be found in Applicant's originally filed specification at, for example, paragraph 0036.

In contrast, Birks is directed entirely to providing additional storage capacity for a network personal video recorder. (Birks, abstract). According to Birks, "[t]he Network PVR (nPVR) of the present invention scales for storage to allow users access to a large quantity of recorded content. It also allows MSOs to provide VCR time-shifted functionality to customers with low-end digital set top boxes." (Birks, paragraph 0043).

Birks does not, however, teach or suggest the method of claim 1 in which a content receiver comprising a set-top box can send commands upstream to obtain Internet access. Applicant's specification describes an augmentation unit 25 "disposed between a content source (for example, a cable television system head-end) and a content receiver 30." (Applicant's specification, paragraph 0037). The augmentation unit 25 receives commands from downstream set-top boxes, in this case, "receiving a command from a downstream content receiver requesting Internet access." The augmentation unit 25 can then, as in claim 1, execute "the command if the command is not directed to a server further upstream, wherein executing the command provides access to the Internet to said downstream content receiver." This method is not taught or suggested by Birks.

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"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, for at least the reasons explained here, the rejection based on Birks of claim 1 and its dependent claims should be reconsidered and withdrawn.

Claim 3:

Claim 3 has been rewritten by the present paper as an independent claim and now recites the following.

A method for expanding the functionality of a content receiver comprising the steps of:
receiving a command from a downstream content receiver; and
if the command is directed to an augmentation unit further upstream, directing the command to said augmentation unit further upstream;
wherein the step of directing the command to an augmentation unit further upstream comprises the steps of:
receiving data packets addressed to an upstream augmentation unit;
generating a modulated carrier signal according to the data packets; and
conveying the modulated carrier signal to an upstream interface.

Thus, like claim 1 above, claim 3 recites "receiving a command from a downstream content receiver." Claim 3 then further recites that, "if the command is directed to an augmentation unit further upstream," the command is directed to the upstream augmentation unit by "receiving data packets addressed to an upstream augmentation unit; generating a modulated carrier signal according to the data packets; and conveying the modulated carrier signal to an upstream interface."

In rejecting claim 3, the Action refers to Birks at Fig. 3, item 310 and paragraph 0028 with the following explanation. "Birks describes the process of receiving a content stream in

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one of many formats, which are intended to be stored further upstream in a storage server.”

(Action, p. 4). The cited paragraph of Birks, paragraph 0028, reads as follows.

The method 300 of FIG. 3 is entered at step 310, when content streams are received. For example, encoded or unencoded content streams may be received via the content introduction point 140 in the system 100 of FIG. 1. Receipt content streams may comprise analog television streams such as those formed according to the NTSC, PAL or other analog television standards, as well as encoded streams formed according to the MPEG, ATSC or other digital video and/or audio encoding schemes. In the case of encoded received streams, transcoding of the received streams into an appropriate encoded format may be provided. For example, it may be desirable to encode all received streams according to a variable bit rate encoding format to assure a maximum level of quality.

(Birks, paragraph 0028).

This, however, is clearly inapplicable to claim 3. As indicated by the Examiner, the cited portions of Birks are directed to the format and handling of downstream “content streams.” In contrast, claim 3 describes the transmission *upstream* of “a command from a downstream content receiver,” not a content stream.

Birks does not teach or suggest directing a command to an augmentation unit further upstream including “receiving data packets addressed to an upstream augmentation unit; generating a modulated carrier signal according to the data packets; and conveying the modulated carrier signal to an upstream interface.” “A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, for at least the reasons explained here, the rejection based on Birks of claim 3 and its dependent claims should be reconsidered and withdrawn.

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Claim 12:

Independent claim 12 recites:

A content receiver augmentation unit comprising:
downstream interface; and
command executive that receives a command from the downstream interface and determines whether the command is addressed to said augmentation unit or a unit further upstream, wherein said command executive executes the command if the command is not directed to a unit further upstream.

Support for the amendment to claim 12 can be found in Applicant's originally filed specification at, for example, paragraph 0027.

In contrast, Birks does not appear to teach or suggest a content receiver augmentation unit comprising a command executive that receives commands from downstream and determines whether the command is addressed to that augmentation unit or another further upstream and then executes the command if the command is not directed to an augmentation unit further upstream. Birks describes a server 120 that may receive commands from clients (170). However, Birks does not teach or suggest that the server 120 determines whether a command it has received is to be executed or directed to another unit further upstream.

Consequently, Birks does not teach or suggest the claimed augmentation unit comprising a "command executive that receives a command from the downstream interface and determines whether the command is addressed to said augmentation unit or a unit further upstream, wherein said command executive executes the command if the command is not directed to a unit further upstream." "A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, for at least the

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reasons explained here, the rejection based on Birks of claim 12 and its dependent claims should be reconsidered and withdrawn.

Rejections under § 103:

Claims 4 and 15 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Birks and U.S. Patent App. Pub. No. 20040016002 to Handelman et al. ("Handelman").

Claims 5 and 16 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Birks, Handelman and U.S. Patent No. 7,305,357 to Hamilton ("Hamilton").

Claims 6, 7, 17 and 18 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Birks and Hamilton.

Claims 10 and 21 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Birks taken alone.

These rejections should all be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of the respective independent claim.

Conclusion:

In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicants reserve the right to set forth further arguments supporting the patentability of their claims, including the separate patentability of the dependent claims not explicitly addressed herein, in future papers. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the

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Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

If any fees are owed in connection with this paper that have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC.

Respectfully submitted,

DATE: July 7, 2008


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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted to the Patent and Trademark Office facsimile number (571) 273-8300 on July 7, 2008. Number of Pages: 18


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